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Guy Rousselin

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUY ROUSSELIN

Appeal 2008-1172
Application 10/671,866
Technology Center 3700

Decided: [Date of mailing]

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and LINDA E.
HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Guy Rousselin (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 5 and 24-26. Claims 1, 2, 12, 14, and 16-23 have been canceled, and claims 3, 4, 6-11, 13, and 15 have been allowed.¹ We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is a fluid distribution flow adjustment device (Spec. 1). Claim 24, reproduced below, is representative of the subject matter on appeal.

24. Fluid distribution flow adjustment apparatus comprising a body arrangement having a fluid outlet and a fluid inlet opening up at one end facing a rotatable disk including holes such that the whole diameter of at least one of the holes always is facing the outlet regardless of the position of the disk about its axis of rotation; the fluid outlet, fluid inlet, the body arrangement and the disk being arranged to enable fluid to flow from the inlet to the outlet without interruption even during rotation of the disk to provide gradual adjustment of the

¹ We note that despite the Examiner's statement in the Final Office Action, page 2, that claims 3-11, 13, and 15 are allowed, claim 5 has been rejected under 35 U.S.C. § 112, first paragraph. A claim cannot be both rejected and allowed. As such, claim 5 is rejected.

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fluid flow rate from the inlet to the outlet as a function of the diameter of the hole(s) and/or the density of the holes facing the outlet.

THE REJECTION

The Appellant seeks our review of the rejection of claims 5 and 24-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 5 and 24-26 under 35 U.S.C. § 112, first paragraph. This issue turns on whether the Appellant's disclosure is sufficient to allow one skilled in the art to visualize or recognize a rotatable disk including holes such that the whole diameter of at least one of the holes always is facing the outlet regardless of the position of the disk about its axis of rotation.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

PRINCIPLES OF LAW

The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The possession test alone, however, is not always sufficient to meet the written description requirement. *Enzo Biochem*, 323 F.3d at 969. Rather, “the written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Id.* (quoting *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)).

The claimed subject matter need not be described “*in haec verba*” in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989). Rather, “the test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed in the later filed application as of the filing date of the earlier filed application.” *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004).

The written description requirement is not necessarily met as a matter of law because the claim language appears *in ipsius verbis* in the specification. *Enzo Biochem*, 323 F.3d at 968 (“The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy [the written description] that requirement.”). “The

disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.” *Id.* (citation omitted).

ANALYSIS

The Examiner rejected claims 5 and 24-26 under 35 U.S.C. § 112, first paragraph, because “[t]here is no disclosure in the original application that the entire diameter of a hole is always exposed to the outlet” (Ans. 3). In particular, the Examiner found the disclosure that at least one hole always faces the outlet is not the same as saying that the whole diameter of a hole always faces the outlet (Ans. 4). Further, the Examiner found that Figure 2 shows that in one position of the disk 6 the entire diameter of a hole faces the outlet 11, but it does not explicitly disclose that this is the case in all positions of the disk (*id.*).

The Appellant contends that the Specification in combination with Figure 2 contains sufficient written description, because Figure 2 shows that the entire diameters of three holes are in the region of area Z, i.e., the area of outlet passage 11 opposite the rows of holes 70 and 71, and as disk 6 rotates about its central axis, the entire diameter of at least one of holes 70₀-70_n or 71₀-71_n is always in the region of area Z (Br. 7).

We agree with the Examiner. The rows of holes 70 and 71 depicted in Figure 2 cover only an arcuate sector on the face of rotatable disk 6. As shown, the holes are discontinued along an arcuate sector on the left side of the disk between holes 70₀ and 71₀ and holes 70_n and 71_n. The Appellant’s Specification states only that disk 6 is fixed in rotation with the knob 5

(Spec. 4:11-12). The Specification does not describe that the disk 6 or the knob 5, in use, is to be rotated only through a particular arcuate sector of the disk. On the contrary, the Specification describes:

The knurled knob (5) is rotated with respect to the body (3) as a result of body (3) including a drilled hole (17) into which stub (56) of knob (5) is inserted, or vice versa, and by the lower face of the knob (5) including an extension in the form of a skirt (51), co-operating with a complementary shaped groove (31) formed in the part of the body (3) facing the face of the knob (5) on which the skirt is formed.

(Spec. 4:20-29.) The hole 17, into which the stub 56 of knob 5 rotates, is round (Fig. 6a) and the groove 31, through which the skirt 51 of knob 5 travels, is circular (Fig. 6a) such that the knob 5, and thus the disk 6, appears free to travel through an entire revolution about its central axis.

The Appellant's Specification also describes that "[t]he area Z, as shown in Figure 2, is such that two or more holes in a single row and / or in different rows always face the area Z" (Spec. 5:30-31). Because there is nothing in the Specification or the Figures showing a way to prevent rotation of the disk through a full revolution, we understand the disclosure at the bottom of page 5 of Appellant's Specification to refer to that period of rotation of the disk during which the arcuate sector of disk 6 containing holes 70 and 71 passes over area Z. We do not understand this disclosure to require that the disk not be capable of rotating a complete revolution.

If disk 6 were rotated a complete revolution about its central axis, then when the hole-less arcuate sector of disk 6 passes over the outlet passage 11,

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no holes would fall within the area Z. As such, Figure 2 does not convey to one skilled in the relevant art that Appellant was in possession of the invention of a fluid distribution flow adjustment apparatus having a rotatable disk including holes such that the whole diameter of at least one of the holes always is facing the outlet regardless of the position of the disk about its axis of rotation. Further, we find nothing else in the Appellant's Specification that conveys this claimed subject matter. As such, the Appellant's Specification and Figures fail to provide adequate written descriptive support for the subject matter of claims 5 and 24-26. Accordingly, we sustain the Examiner's rejection of claims 5 and 24-26 under 35 U.S.C. § 112, first paragraph.

CONCLUSION

We conclude the Appellant has failed to show that the Examiner erred in rejecting claims 5 and 24-26 under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description requirement.

DECISION

The decision of the Examiner to reject claims 5 and 24-26 is affirmed. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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AFFIRMED

APJ Initials:

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